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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,176	04/04/2001	Norihito Morikage	259A 3065	2869

7590 03/10/2004

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 03/10/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/826,176	MORIKAGE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Haythim J. Alaubaidi	2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 April 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) 7-12, 17 and 19 is/are withdrawn from consideration.  
 5) Claim(s) 16 is/are allowed.  
 6) Claim(s) 1-3, 5, 13-15, 18 and 20 is/are rejected.  
 7) Claim(s) 4 and 6 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 04 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date 4. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. Claims 1-6, 13-16, 18 and 20 are drawn to keyword retrieval and query processing, classified in class 707, subclass 3.
- B. Claims 7-12, 17 and 19, are drawn to history matching of patterns, classified in class 707, subclass 6.

Inventions A - B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention **A** has separate utility such as retrieving law cases associated with keywords, verbs and objects; and invention **B** has separate utility such as the analysis of matching history patterns. Each of the two inventions does not require the particulars of the other invention.

During a telephone conversation with Mr. Henry Koda on March 5, 2004 a provisional election was made with traverse to prosecute invention A, Claims 1-6, 13-16, 18 and 20. Affirmation of this election must be made by the Applicant in replying to this office action. Claims 7-12, 17 and 19 are withdrawn from further consideration by the examiner, according to 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **DETAILED ACTION**

1. Claims 1-6, 13-16, 18 and 20 are presented for examination following the Election/Restriction above.
2. Claims 7-12, 17 and 19, are withdrawn from further consideration.
3. Claims 5 and 15, is rejected under 35 U.S.C. 102(e).
4. Claims 3, 13-14 and 18, is rejected under 35 U.S.C. 103(a)
5. Claims 1-2 and 20, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph.
6. Claims 4, and 6, are objected to as being dependent upon a rejected base claim.
7. Claim 16 is allowed over the prior art of record.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Regarding claims 1-2 and 20, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
10. Regarding claim1-3 and 20, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 5 and 15, is rejected under 35 U.S.C. 102(e) as being anticipated by Nicholas J. Davies (U.S. Patent No. 6,353,827 and Davies hereinafter).

Regarding Claims 5 and 15, Davies discloses:

a verb and object database constructed by associated verbs and objects related to each other (Abstract; see also Col 2, Lines 17-29; see also Col 12, Lines 51-54)  
and by associated retrieval keywords related to the combination of them (verb and object) (Col 12, Lines 51-54)

a retrieval processing portion for obtaining a retrieval keyword associated with a combination of a received verb and object (Col 3, Lines 36-41; see also Col 6, Line 6 through Col 7, Line 8; see also Col 16, Lines 1-5).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3, 13-14 and 18, is rejected under 35 U.S.C. 103(a) as being unpatentable over Michael Walfish (U.S. Patent No. 6,047,300 and Walfish hereinafter) in view of Aristotle Balogh (U.S. Patent No. 5,893,101 and Balogh hereinafter).

Regarding Claims 3, 13-14 and 18, Walfish discloses:

associating non-retrieval keywords (misspelled) with retrieval keywords adequate for replacing the non-retrieval keywords (Col 2, Lines 48-58)

an information analysis portion for determining whether or not a received keyword is a non-retrieval keyword (Col 2, Line 65-67)

a retrieval processing portion when the determination for the keyword is a non-retrieval keyword, the system will read the associated retrieval keyword (Col 2, Line 67 through Col 3, Line 13)

Walfish reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the meta-keyword database. However Balogh teaches a meta-keyword database (Abstract; see also Col 1, Lines 57-64).

Given the intended broad application of Walfish's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to

modify the teachings of Walfish with the teachings of Balogh to include a database storage for the metadata (meta-keyword) and not just the memory of the PC that was stated by Walfish, as the reference is teaching at the PC level of a word processing document, and it would be obvious to substitute the memory with a database to increase the systems performance and allow for a larger storage in addition to maximizing the retrieval speed of the keyword.

***Allowable Subject Matter***

15. Claims 1-2 and 20, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
16. Claims 4, and 6, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
17. Claim 16, is allowed over the prior art of record.
18. The following is the Examiner's statement of reasons for the indication of allowable subject matter:

Regarding Independent Claims 1-2 and 20, Applicant's particular system for query pattern prediction is the combination of predicting an information gathering query patterns for law cases by constructing a database that associate verbs and objects related to each other and associating retrievable keywords related to the combination of them (verb and object); in combination with the limitation of matching a retrieval pattern

by a received retrieved keyword with a pattern of an aid flowchart in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

Regarding Claim 4, Applicant's particular system is wherein the meta-keyword database is set such that the non-retrieval keyword and a law term having meaning equal or similar thereto as the retrieval word associated with the non-retrieval keyword are on-to-one or on-to-many in combination with the limitation of matching a retrieval pattern by a received retrieved keyword with a pattern of an aid flowchart in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

Regarding Claims 6 and 16, Applicant's particular system is the combination of having an information analysis portion to determine whether the received keyword is a verb or an object; and for reading the other object or verb associated therewith; in combination with the retrieval processing portion that receives the other verb or object after the output of the input/output processing portion to obtain a retrieval keyword associated with a combination of the verb and the object in combination with the limitation of matching a retrieval pattern by a received retrieved keyword with a pattern of an aid flowchart in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

***Other Prior Art Made of Record***

19. a. kiewicz et al. (U.S. Patent No. 6651253) discloses an interactive system and method for generating metadata for programming events;
- b. Tokuda et al. (U.S. Patent No. 6401073) discloses a mod and system for managing workflow;
- c. ister et al. (U.S. Patent No. 5371807) discloses a method and apparatus for text classification; and
- d. Oakes et al. (Non Patent Literature) discloses a method of automated assistance in the formulation of search statements for bibliographic databases.

***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

***Points of Contact***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

*Haythim J. Alaubaidi*

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Patent Examiner  
Technology Center 2100  
March 5, 2004



SAFET METJAHIC  
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